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Renee M. Kovales

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IBM CORPORATION

C/O: VanCott Bagley, Cornwall & McCarthy

36 South State Street

Suite 1900

Salt Lake City, UT 84111

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PHAN, JOSEPH T

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/782,772  
Filing Date: February 13, 2001  
Appellant(s): KOVALES ET AL.

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Steven L. Nichols  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 01/14/2010 appealing from the Office action mailed 04/15/2009.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

1, 3, 6-14, 17-33, 35, 37-41, 44-58, 61-68, and 71-88.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner.

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

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5,943,402	Hamel et al.	08-1999
6,442,243	Valco et al.	08-2002
6,970,906	Parson et al.	11-2005
5,742,736	Haddock	04-1998

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claims 1, 3, 6-7, 12-14, 17-20, 22-33, 35, 37, 41, 44-47, 49-58, 61-62, 67-68, 71-72, 74-81, and 83-88 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel et al., Patent #5,943,402 in view of Valco et al., Patent #6,442,243.**

Regarding claims 1, 33, and 57, Hamel teaches a method, system and computer readable medium providing bookmarks for a voice mail message by a caller leaving the voice mail message(col.2 lines 12-21); and creating a bookmarked message from the voice mail message and the bookmarks(110/120a of Fig.2D and col.5 lines 34-48), wherein at least two of the bookmarks are used to mark respective segments of the voice mail message(Fig.3A-3B), and wherein at least some of the bookmarks correspond to respective topics (col.1 line 58-col.2 line 21; the voicemail message and comments are topics).

Hamel is silent on disclosing the bookmarks corresponds to topics and segments having different ones of the degrees of importance.

However, Valco teaches bookmarks having topics and different ones of degrees of importance(Valco col.12 lines 55-59).

In the same field of endeavor of a caller managing voicemails, It would have been

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obvious to a person of ordinary skill in the art at the time the invention was made to modify Hamel's marked segments in a voicemail(Fig.3A) to include different ones of the degrees of importance as taught by Valco in order to distinguish the segment as urgent or not as this would allow a more efficient way to manage and utilize voicemails.

Furthermore, Hamel expressly discloses that prior art voicemail systems, Valco is one, can be used to manipulate Hamel's voicemail system(col.2 lines 3-12) and therefore further establishes *prima facie*.

It is also noted that Valco uses the same standard twelve key touch tone telephone keypad as suggested by Hamel(col.2 lines 19-21 and col.3 lines 6-10) for marking to further simplify the combination.

Regarding claims 3 and 35, Hamel in view of Valco teaches the method and system according to claims 1 and 33, further comprising means for playing the bookmarked message to a listener(85 Fig.2C, 110 and 120a of Fig.2D).

Regarding claims 6 and 61, Hamel in view of Valco teaches the method, system and computer readable medium according to Claims 1, 37, and 57 wherein a default degree of importance is associated with at least one of the respective segments (Valco col.12 lines 55-59).

Regarding claims 7, 37, and 62, Hamel in view of Valco teaches the method, system and computer readable medium according to claims 1, 33, and 57 wherein at least one of the bookmark corresponds to one or more special types of information in the voice mail message (Valco col.12 lines 55-59 or Hamel col.1 line 58-col.2 line 21; urgent or private comments or voicemails in general are special types of information).

Regarding claim 67 Hamel in view of Valco teaches a computer readable medium

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according to claim 59 further comprising code configured to use the at least one bookmark to navigate from one topic of the voicemail to another(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 13, 40, and 66 **Hamel** in view of Valco teaches the method according to claim 7, wherein at least one of the special types of information is a protection or confidentiality indicator message (Valco col.12 lines 55-59; private is confidential).

Regarding claim 14, 41, and 68, **Hamel** in view of Valco teaches a method, system and computer readable medium according to claims 2, 34, and 58 further comprising the step of using the at least one bookmark to perform actions selectively on one or more segments of the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67; listening to the segment is an action*).

Regarding claims 17, 47, and 72 **Hamel** in view of Valco teaches a method, system and computer readable medium according to claims 14, 41 and 68, wherein the selected respective segments are associated with one or more special types of information in the voice mail message(*col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claim 18, 44, and 71, **Hamel** in view of Valco teaches a method, system and computer readable medium according to claims 14, 41, and 68, wherein the actions comprise one or more of saving, deleting, forwarding, listening, skipping, or repeating one or more of the selected respective segments, and marking a particular segment as protected or confidential prior to forwarding the marked segment to another party (Valco *col.12 lines 55-59*).

Regarding claim 19 and 45 **Hamel** in view of Valco teaches a method, system and computer readable medium according to claims 18 and 44, wherein the actions further comprise

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marking at least one of the selected segment as protected or confidential (*Valco col.12 lines 4-7 and 55-59*).

Regarding claim 20 and 46 **Hamel** in view of Valco teaches a method, system and computer readable medium according to claims 19 and 45 further comprising forwarding the segment marked as protected or confidential to another party (*Valco col.11 lines 45-55 and col.12 lines 55-59*).

Regarding claim 22 **Hamel** in view of Valco teaches the method according to claim 1, wherein the creating step further comprises storing the bookmarks and the voice mail message separately as the bookmarked message (*Hamel 85 Fig.2C, 110/120a of Fig.2D*).

Regarding claim 23 **Hamel** in view of Valco teaches the method according to claim 2 wherein the creating step further comprises storing the bookmarks and the voice mail message intermingled as the bookmarked message(*Hamel 85 Fig.2C, 110/120a of Fig.2D*).

Regarding claims 24, 49, and 74 **Hamel** in view of Valco teaches a method, system and computer readable medium according to claims 3, 35, and 58, further comprising announcing for the bookmarked voice mail message, a number of the bookmarked segments in the voicemail message (*Valco col.5 lines 21-38, Hamel col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 25-26, 50, 75, 83-86 **Hamel** in view of Valco teaches a method, system and computer readable medium according to claims 1, 3, 7, 33, 35, 37, 58, 60, and 62 further comprising announcing, before, during, or after playing the voicemail message, the different degree of importance in the voice mail message and a number of segments thereof(*Valco col.5 lines 21-38, Hamel col.5 lines col.5 lines 22-48, col.7 lines 1-8, and col.8 lines 35-67; displaying is also announcing*).

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Regarding claims 27, 51, 76, 87-88 Hamel in view of Valco teaches a method, system and computer readable medium according to claims 3, 5, 7, 35, 37, 43, 58, 60, and 62 further comprising announcing, before and after playing the voicemail message, the special types of information in the voicemail message(*Valco col.5 lines 21-38, Hamel col.5 lines col.5 lines 22-48, col.7 lines 1-8, and col.8 lines 35-67; displaying is announcing*).

Regarding claims 28, 52, and 77 Hamel in view of Valco teaches the method, system and computer readable medium according to claims 7, 37, and 62 wherein particular ones of the special types of information are required, and further comprising the step of prompting the caller to provide input for each particular one for which no bookmark is otherwise provided(*col.5 lines 16-48, and col.8 lines 35-67, Valco col.5 lines 21-38*).

Regarding claims 29, 53, and 78 Hamel in view of Valco teaches the method, system and computer readable medium according to claims 1, 33, and 58 further comprising the step of associating one or more audio cues with one or more bookmarks of the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 30, 54, and 79 Hamel in view of Valco teaches the method, system and computer readable medium according to claims 29, 53, and 78 further comprising the steps of playing the bookmarked message to a listener; and incorporating the one or more associated audio cues along with respective portions of the voice mail message corresponding to the one or more bookmarks (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 31, 55, and 80 Hamel in view of Valco teaches the method, system and computer readable medium according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue



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with its respective portion of the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 32, 56, and 81 **Hamel** in view of Valco teaches the method, system and computer readable medium according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue in-line with its respective portion of the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

**Claims 8-10, 12, 38, 40, and 63-66 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel in view of Valco further in view of Parsons et al., Patent #6,970,906.**

Regarding claims 8-10, 12, 38, 40, and 63-66 **Hamel** in view of Valco teaches the method, system and computer readable medium according to claims 7, 37, and 62.

Hamel is silent about disclosing wherein at least one of the special types of information is one of a: callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; or an email address.

However, in a related field of managing voicemails and callers able to bookmark voicemails, Parsons teaches wherein at least one of the special types of information is one of a: callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address (*Parsons col.5 lines 1-6, col.6 lines 16-35 and col.9 lines 49-57*).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hamel's marked segments invention(Fig.3A) to include in the voicemail message, a callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; or an email address.

One would have been motivated to do so as leaving special types of information in a voicemail message was old and well-known at the time the invention was made. It is understood that the content of voicemail messages can comprise of an indefinite variety of information and would be obvious as this would allow a more efficient way of managing and handling voicemails.

Furthermore, Hamel expressly discloses that a prior art voicemail system, e.g. Parsons, can be used to manipulate Hamel's voicemail system(col.2 lines 3-12) and therefore further establishes the prima facie combination.

**Claims 11, 21, 39, 48, and 73 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel in view of Valco further in view of Haddock, Patent #5,742,736.**

Regarding claims 11, 21, 39, 48, and 73 Hamel in view Valco teaches a method, system and computer readable medium according to claims 17, 37, 47, and 72.

Hamel is silent on wherein at least one of the special types of information comprises a uniform resource locator(URL) and where at least one of the actions comprises automatically establishing a connection to the URL.

However, in the same field of endeavor, Haddock teaches viewing and manipulating

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voice mail messages on a computer display and the contents thereof can be retrieved and connected to applications on the computer (col.4 lines 38-54).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include a computer display like in Haddock to view and access information within voice mail messages as taught in Hamel(col.1 lines 45-52).

One of ordinary skill in the art would have been motivated to do this as automatically connecting to a URL via a displayed hyperlink is old and well-known in the art and since Haddock's user is able to use information(e.g. phone #, points of interest, etc.) to automatically establish a connection to it, URL's are just an example of points of interest that can be accessed with a computer application(e.g. "Internet Explorer").

Furthermore, Hamel expressly discloses that features in a prior art voicemail system, e.g. Haddock, can be used to manipulate Hamel's voicemail system(col.2 lines 3-12) and therefore further establishes the prima facie combination.

#### **(10) Response to Arguments**

I. Regarding method claims 1, 3, 6, 14, 17-20, 23, and 25-32, Appellant presents arguments for claim 1 in which claims 3, 6, 14, 17-20, 23, and 25-32 stands or falls with.

Appellant argues that Hamel in view of Valco does not render the subject matter of claim 1 obvious and that Hamel and Valco individually, fails to teach or suggest that "at least two of the bookmarks are used to mark respective segments of voice mail messages as having degrees of importance" and that "some of the respective respective segments having different ones of the different ones of the degrees of importance" (page 11 of appeal brief).

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The examiner agrees with the appellant that individually, Hamel or Valco, does not teach the argued limitations as a whole.

However, the examiner applies a combination rejection of Hamel in view of Valco under 35 U.S.C 103(a) to render the subject matter of claim 1 obvious.

Applicant also argues that because Valco only teaches marking an entire voicemail message with a single degree of importance, Valco cannot teach or suggest a single voice mail message having different degrees of importance associated therewith(bottom of page 11-appeal brief). It is noted that the examiner does not apply Valco alone to teach a single voicemail having different degrees of importance. The examiner applies Valco(in a related field of a caller being able to mark his voicemail) as a secondary reference to teach marking voicemails as urgent, private, etc(Valco col.12 lines 55-59).

The appellant again argues that Neither Hamel nor Valco teach bookmarks that not only segment a voicemail message, but also indicate the degree of importance associated with each segment(middle paragraph on page 12-appeal brief). The examiner again reiterates that Hamel is applied as the primary reference to teach segmentation(bookmarking) of a voicemail message (Hamel Fig.3A-3B and col.1 lines 58-67) with Valco applied as the secondary reference to teach the degrees of importance(Valco col.12 lines 55-59) as shown in the 35 U.S.C. 103 rejection above. This combination as explained above, establishes prima facie case of obviousness.

Regarding system claims 33, 35, 41, 44-47, and 50-56, Appellant states that they stand or fall together with independent claim 33. The examiner acknowledges that the same arguments presented for claim 1 above are repeated by the appellant for claim 33 and therefore for conciseness, the examiner uses the same response to arguments as set forth above in claim 1.

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Regarding computer readable medium claims 57-58, 61, 67-68, 71-72, and 75-81, Appellant states that they stand or fall together with independent claim 57. The examiner acknowledges that the same arguments presented for claim 1 above are repeated by the appellant for claim 57 and therefore for conciseness, the examiner uses the same response to arguments as set forth above in claim 1.

Regarding claims 7, 37, and 62, Appellant argues that Valco does not teach 'wherein at least one of the bookmarks corresponds to one or more special types of information in the voice mail message'. As shown in the 103 rejection above, the examiner applies Hamel in view of Valco, and not Valco alone, to teach the limitations. It is noted that Hamel teaches the bookmark feature(Fig.3A-3B).

Regarding claim 12 which depends from claim 7, Appellant states that the Final Office Action rejects claim 12 on the basis of Hamel and Valco alone(page 17 of appeal brief) which is inaccurate.

As shown in the 103 rejection above, the examiner applies Hamel in view of Valco further in view of Parsons to teach claim 12. It is noted that Parsons is also capable of allowing a caller to mark his voicemail messages(col.6 lines 16-35 and col.9 lines 49-57).

Regarding claim 13 which depends from claim 7, Appellant argues that Valco does not teach 'wherein at least one of the special types of information is a protection or confidentiality indicator'. However, as shown in the 103 rejection above for claim 13, Valco does teach marking a voicemail as private which is obvious that the special type of information indicates protected or confidential.

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Regarding claim 22 which depends from claim 1, Appellant contends that the examiner utilizes the suppressed/deleted example in Fig.2 step 85 of Hamel for support, However, this is inaccurate. Step 85 of Fig.2C in Hamel also shows that by pressing 2, the current segment is sent which is the temporarily stored bookmarked message and is further supported by Fig.2D steps 110 and 120a and col.1 lines 64-66.

Regarding claims 24, 49, and 74 which are dependent claims. Appellant contends that the Hamel and Valco does not teach ‘announcing, for the bookmarked message, a number of the bookmarked segments in the voice mail message’. However, the claim merely recites announcing, for the bookmarked message, a number of the bookmarked segments. It does not recite numbering the bookmarked segments in sequential or numerical order and announcing the numerical number of the ordered bookmarked segments. Therefore the examiner interprets announcing a number of the bookmarked segments, as Hamel discloses in col.5 lines 24-26, as announcing the number  $\frac{1}{2}$  of the current bookmarked segment of the plurality of bookmarked segments(Fig.3A-3B). Valco also announces a number of messages(bookmarked segments in view of Hamel) (Valco col.5 lines 20-35).

**II.** Regarding claims 8-10, 12, 38, 40, and 63-66, Appellant argues that Parsons cannot be used to teach these claims since Parsons fails to teach or suggests bookmarks in voice mail message at all. It is reiterated again that the examiner does not apply Parson alone to teach the limitations, rather the 103 rejections discussed above applies Hamel, Valco, and Parsons to establish prima facie case of obviousness.

**III.** Regarding claims 11, 21, 39, 48, and 73, Appellant states that the same reasons given

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above apply to these claims. Therefore the examiner presents the same response to arguments as set forth above.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Joseph T Phan/

Examiner, Art Unit 2614

Conferees:

/CURTIS KUNTZ/

Supervisory Patent Examiner, Art Unit 2614

/Vivian Chin/

Supervisory Patent Examiner, Art Unit 2614